



## DEPARTMENT OF COMMERCE

### United States Patent and Trademark Office

#### Agency Information Collection Activities; Submission to the Office of Management and Budget (OMB) for Review and Approval; Comment Request; Patent Reexaminations, Supplemental Examinations, and Post Patent Submissions

**ACTION:** Notice of information collection; request for comment.

**SUMMARY:** The United States Patent and Trademark Office (USPTO), as required by the Paperwork Reduction Act of 1995, invites comments on the extension and revision of an existing information collection: 0651-0064 (Patent Reexaminations, Supplemental Examinations, and Post Patent Submissions). The purpose of this notice is to allow 60 days for public comment preceding submission of the information collection to OMB.

**DATES:** To ensure consideration, comments regarding this information collection must be received on or before **[INSERT DATE 60 DAYS AFTER THE DATE OF PUBLICATION IN THE FEDERAL REGISTER]**.

**ADDRESSES:** Interested persons are invited to submit written comments by any of the following methods. Do not submit Confidential Business Information or otherwise sensitive or protected information.

- *Email:* [InformationCollection@uspto.gov](mailto:InformationCollection@uspto.gov). Include “0651-0064 comment” in the subject line of the message.
- *Federal Rulemaking Portal:* <http://www.regulations.gov>.

- *Mail:* Kimberly Hardy, Office of the Chief Administrative Officer, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450

**FOR FURTHER INFORMATION CONTACT:** Requests for additional information should be directed to Parikha Mehta, Legal Advisor, Office of Patent Legal Administration, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450; by telephone at 571-272-3248; or by email to Parikha.Mehta@uspto.gov with “0651-0064 comment” in the subject line. Additional information about this information collection is also available at <http://www.reginfo.gov> under “Information Collection Review.”

**SUPPLEMENTARY INFORMATION:**

**I. Abstract**

The USPTO is required by 35 U.S.C. 131 and 151 to examine applications and, when appropriate, allow applications and issue them as patents. Chapter 30 of Title 35 U.S.C. provides that any person at any time may file a request for reexamination by the USPTO of any claim of a patent on the basis of prior art cited under the provisions of 35 U.S.C. 301. Once initiated, the reexamination proceedings under Chapter 30 are substantially *ex parte* and do not permit input from third parties. The regulations outlining *ex parte* reexaminations are found at 37 CFR 1.510-1.570.

In addition, 35 U.S.C. 257 permits a patent owner to request supplemental examination of a patent by the USPTO to consider, reconsider, or correct information believed to be relevant to the patent. The regulations outlining supplemental examination are found at 37 CFR 1.601-1.625.

The Leahy-Smith America Invents Act terminated *inter partes* reexamination effective September 16, 2012. However, *inter partes* reexamination proceedings based on *inter partes* reexamination requests filed before September 16, 2012, continue to be prosecuted. Therefore, this information collection continues to include items related to

the prosecution of *inter partes* reexamination proceedings. The regulations outlining *inter partes* reexamination are found at 37 CFR 1.903-1.959.

The provisions of 35 U.S.C. 301 and 37 CFR 1.501 govern the ability of a person to submit into the file of an issued patent (1) prior art consisting of patents or printed publications which the person making the submission believes to have a bearing on the patentability of any claim of the issued patent and (2) statements of the owner of the issued patent filed in a proceeding before a Federal court or the USPTO in which the owner of the issued patent took a position on the scope of any claim of the issued patent.

This information collection covers information contained in: (1) requests for *ex parte* reexamination, (2) requests for supplemental examination, (3) submissions made by patent owners and third-party requesters related to the prosecution of an *ex parte* or *inter partes* reexamination proceeding, (4) information submitted by the public to aid in ascertaining the patentability and/or scope of the claims of the issued patent, and (5) information submitted by patent owners regarding a position taken before the USPTO or a Federal court regarding the scope of any claim in their issued patent. The USPTO's use of the statements of the patent owners ((5) above) will be limited to determining the meaning of a patent claim in *ex parte* reexamination proceedings that already have been ordered and in *inter partes* review and post grant review proceedings that already have been instituted.

The purpose of this information collection is to facilitate requests for *ex parte* reexamination and supplemental examination, to facilitate prosecution of reexamination and reissue proceedings, and to ensure that the associated documentation is submitted to the USPTO, and to permit relevant post-patent prior art and claim scope information to be entered into a patent file.

This renewal request incorporates an item that was previously approved under OMB control number 0651-0067 (Post Patent Public Submissions), specifically

'information disclosure citations'. The title of this information collection is being updated to reflect that change with the inclusion of "Post Patent Submissions". As the information disclosure citation was the only item contained in 0651-0067, that information collection will be discontinued.

## **II. Method of Collection**

The items in this information collection may be submitted online using the Patent Electronic Systems (EFS-Web or Patent Center), or on paper by either mail or hand delivery.

## **III. Data**

*OMB Control Number:* 0651-0064.

*Form Numbers:* (SB = Specimen Book)

- PTO/SB/42 (Information Disclosure Citation in a Patent).
- PTO/SB/57 (Request for Ex Parte Reexamination Transmittal Form).
- PTO/SB/59 (Request for Supplemental Examination Transmittal Form).

*Type of Review:* Extension and revision of a currently approved information collection.

*Affected Public:* Private sector; individuals or households.

*Estimated Number of Respondents:* 864 respondents per year.

*Estimated Number of Responses:* 880 responses per year.

*Estimated Time per Response:* The USPTO estimates that it takes the public approximately between 30 minutes (0.5 hours) to 55 hours, depending on the complexity of the situation and item, to gather the necessary information, prepare the appropriate document(s), and submit the information to the USPTO.

*Estimated Total Annual Respondent Burden Hours:* 23,574 hours.

*Estimated Total Annual Respondent (Hourly) Cost Burden:* \$9,429,600.

### **Table 1: Total Hourly Burden for Private Sector Respondents**

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year) (a)	Estimated Time for Response (hour) (b)	Estimated Annual Burden (hour/year) (a) x (b) = (c)	Rate <sup>1</sup> (\$/hour) (d)	Estimated Annual Respondent Cost Burden (c) x (d) = (e)
1	Request for Supplemental Examination  <b>PTO/SB/59</b>	31	31	25	775	\$400	\$310,000
2	Request for <i>Ex Parte</i> Reexamination  <b>PTO/SB/57</b>	177	177	55	9,735	\$400	\$3,894,000
3	Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	68	68	23	1,564	\$400	\$625,600
4	Patent Owner's 37 CFR 1.530 Statement	53	53	8	424	\$400	\$169,600
5	Third Party Requester's 37 CFR 1.535 Reply	9	9	8	72	\$400	\$28,800
6	Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	230	230	33	7,590	\$400	\$3,036,000
7	Third Party Requester's 37 CFR 1.947 Comments in <i>Inter Partes</i> Reexamination	1	1	41	41	\$400	\$16,400
8	Response to Final Rejection in <i>Ex Parte</i> Reexamination	118	118	17	2,006	\$400	\$802,400
9	Patent Owner's 37 CFR 1.951 Response in <i>Inter Partes</i> Reexamination	2	2	41	82	\$400	\$32,800
10	Third Party Requester's 37 CFR 1.951 Comments in <i>Inter Partes</i> Reexamination	2	2	41	82	\$400	\$32,800
11	Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	116	116	0.5	58	\$400	\$23,200

<sup>1</sup> 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPAL); <https://www.aipal.org/detail/journal-issue/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour. The hourly rate for paraprofessional/paralegals is estimated at \$145 from data published in the 2018 Utilization and Compensation Survey by the National Association of Legal Assistants (NALA)

12	Information Disclosure Citation in a Patent  <b>PTO/SB/42</b>	32	48	10	480	\$400	\$192,000
	<b>Total</b>	<b>839</b>	<b>855</b>		<b>22,909</b>		<b>\$9,163,600</b>

**Table 2: Total Hourly Burden For Individuals or Households Respondents**

Item No.	Item	Estimated Annual Respondents	Estimated Annual Responses (year) (a)	Estimated Time for Response (hour) (b)	Estimated Annual Burden (hour/year) (a) x (b) = (c)	Rate <sup>2</sup> (\$/hour) (d)	Estimated Annual Respondent Cost Burden (c) x (d) = (e)
1	Request for Supplemental Examination  <b>PTO/SB/59</b>	1	1	25	25	\$400	\$10,000
2	Request for <i>Ex Parte</i> Reexamination  <b>PTO/SB/57</b>	5	5	55	275	\$400	\$110,000
3	Petition in a Reexamination Proceeding (except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d))	2	2	23	46	\$400	\$18,400
4	Patent Owner's 37 CFR 1.530 Statement	1	1	8	8	\$400	\$3,200
6	Amendment in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	7	7	33	231	\$400	\$92,400
8	Response to Final Rejection in <i>Ex Parte</i> Reexamination	4	4	17	68	\$400	\$27,200
11	Petition to Request Extension of Time in <i>Ex Parte</i> or <i>Inter Partes</i> Reexamination	4	4	0.5	2	\$400	\$800
12	Information Disclosure Citation in a Patent  <b>PTO/SB/42</b>	1	1	10	10	\$400	\$4,000
	<b>Total</b>	<b>25</b>	<b>25</b>		<b>665</b>		<b>\$266,000</b>

*Estimated Total Annual Respondent (Non-hourly) Cost Burden:* \$2,439,335. There are no capital start-up, recordkeeping, or maintenance costs associated with this information

<sup>2</sup> 2019 Report of the Economic Survey, published by the Committee on Economics of Legal Practice of the American Intellectual Property Law Association (AIPLA); <https://www.aipla.org/detail/ journal-issue/2019-report-of-the-economic-survey>. The USPTO uses the mean rate for attorneys in private firms which is \$400 per hour. The hourly rate for paraprofessional/paralegals is estimated at \$145 from data published in the 2018 Utilization and Compensation Survey by the National Association of Legal Assistants (NALA)

collection. However, this information collection does have annual (non-hour) costs in the form of postage costs and filing fees. Therefore, the USPTO estimates that the total annual (non-hour) cost burden for this information collection, in the form of filing fees (\$2,439,195) and postage costs (\$140) is approximately \$2,439,335.

### Filing Fees

There are nine filing fees associated with this information collection, which are broken down by undiscounted entity, small entity, and micro entity. These fees are listed in the table below.

**Table 3: Filing Fees (Non-hour) Cost Burden**

Item No.	Item	Estimated Annual Responses (a)	Filing Fee (\$) (b)	Total Non-hour Cost Burden (yr) (a) x (b) = (c)
1	Supplemental Examination Request (undiscounted entity)	22	\$4,620	\$101,640
1	Supplemental Examination Request (small entity)	14	\$2,310	\$32,340
1	Supplemental Examination Request (micro entity)	1	\$1,155	\$1,155
1	Supplemental Examination Reexamination (undiscounted entity)	28	\$12,700	\$355,600
1	Supplemental Examination Reexamination (small entity)	15	\$6,350	\$95,250
1	Supplemental Examination Reexamination (micro entity)	1	\$3,175	\$3,175
1	Supplemental Examination document size fees, 21-50 documents (undiscounted entity)	3	\$180	\$540
1	Supplemental Examination document size fees, 21-50 documents (small entity)	3	\$90	\$270
1	Supplemental Examination document size fees, 21-50 documents (micro entity)	1	\$45	\$45
1	Supplemental examination document size fees, each additional 50 documents (undiscounted entity)	3	\$300	\$900
1	Supplemental examination document size fees, each additional 50 documents (small entity)	1	\$150	\$150
1	Supplemental examination document size fees, each additional 50 documents (micro entity)	1	\$75	\$75
2	Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (undiscounted entity)	23	\$480	\$11,040
2	Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (small entity)	12	\$240	\$2,880
2	Reexamination independent claims in excess of three and also in excess of the number of such claims in the patent under reexamination (micro entity)	1	\$120	\$120
2	Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (undiscounted entity)	38	\$100	\$3,800
2	Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (small entity)	17	\$50	\$850

2	Reexamination claims in excess of 20 and also in excess of the number of claims in the patent under reexamination (micro entity)	1	\$25	\$25
2	<i>Ex Parte</i> Reexamination (§1.510(a)) Streamlined (undiscounted entity)	22	\$6,300	\$138,600
2	<i>Ex Parte</i> Reexamination (§1.510(a)) Streamlined (small entity)	40	\$3,150	\$126,000
2	<i>Ex Parte</i> Reexamination (§1.510(a)) Streamlined (micro entity)	2	\$1,575	\$3,150
2	<i>Ex Parte</i> Reexamination (§1.510(a)) Non-Streamlined (undiscounted entity)	86	\$12,600	\$1,083,600
2	<i>Ex Parte</i> Reexamination (§1.510(a)) Non-Streamlined (small entity)	56	\$6,300	\$352,800
2	<i>Ex Parte</i> Reexamination (§1.510(a)) Non-Streamlined (micro entity)	14	\$3,150	\$44,100
3	Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (undiscounted entity)	34	\$2,040	\$69,360
3	Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (small entity)	11	\$1,020	\$11,220
3	Petitions in a reexamination proceeding, except for those specifically enumerated in 37 CFR 1.550(i) and 1.937(d) (micro entity)	1	\$510	\$510
	<b>Total</b>			<b>\$2,439,195</b>

### Postage Costs

The USPTO expects that at most 2% of the responses in this information collection will be submitted by mail. The USPTO estimates that the average postage cost for a mailed submission, using a Priority Mail 2-day flat rate legal envelope, will be \$8.25. The USPTO estimates approximately 17 submissions per year may be mailed to the USPTO, for a total postage cost of \$140 per year.

*Respondent's Obligation:* Required to obtain or retain benefits.

## **IV. Request for Comments**

The USPTO is soliciting public comments to:

- a) Evaluate whether the proposed collection of information is necessary for the proper performance of the functions of the Agency, including whether the information shall have practical utility;
- b) Evaluate the accuracy of the Agency's estimate of the burden of the proposed collection of information, including the validity of the methodology and assumptions used;



- c) Enhance the quality, utility, and clarity of the information to be collected; and
- d) Minimize the burden of the collection on those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

All comments submitted in response to this notice are a matter of public record. The USPTO will include or summarize each comment in the request to OMB to approve this information collection. Before including an address, phone number, email address, or other personal identifying information (PII) in a comment, be aware that the entire comment—including PII —may be made publicly available at any time. While you may ask in your comment to withhold PII from public view, the USPTO cannot guarantee that it will be able to do so.

**Kimberly Hardy,**

*Information Collections Officer,*

*Office of the Chief Administrative Officer,*

*United States Patent and Trademark Office.*

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